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RECORD OF ORAL HEARING
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

EX PARTE NOBUYUKI KIHARA and TEPPEI YOKOTA

Appeal 2008-005448
Application 09/674,441
Technology Center 2400

Oral Hearing Held: June 11, 2009

Before HOWARD B. BLANKENSHIP, ST. JOHN COURTENAY, III, and
STEPHEN C. SIU, *Administrative Patent Judges*.

APPEARANCES:

ON BEHALF OF THE APPELLANTS:

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1 The above-entitled matter came on for oral hearing on Thursday, June
2 11, 2009, at The U.S. Patent and Trademark Office, 600 Dulany Street,
3 Alexandria, Virginia, before Victoria L. Wilson, Notary Public.

4
5 THE USHER: Good afternoon. Calendar number 39. Mr. Smith.

6 JUDGE BLANKENSHIP: Good afternoon, Mr. Smith.

7 MR. SMITH: Good afternoon, Judge Blankenship.

8 JUDGE BLANKENSHIP: You have 20 minutes. You can begin
9 whenever you like.

10 MR. SMITH: My name is Arthur Smith. I'm here on behalf of the
11 Appellants in application number 09/674,441 and I guess I could just start
12 off by maybe discussing the application a little bit, the background.

13 Specifically, this invention is related to digital rights management.
14 What we are doing is we are trying to prevent a circumvention of the digital
15 rights management by using a move copy history file that is checked for files
16 copied further.

17 The one example that this invention is trying to circumvent is where
18 you have digital data stored on a hard drive and then that digital data is then
19 copied or moved to a portable device, such as a flash RAM.

20 Normally during that transaction you will have different security keys
21 being exchanged, different encryptions involved to prevent unauthorized
22 copying or movement of the file. But what happens is that the user could --
23 before that could copy the file to a separate hard drive and, then, now two
24 hard drives have digital data and they are able to download that data to two
25 separate DRAM devices.

1 So what this, the claimed invention, does is it uses a copy move file
2 history so whenever the file is copied, a record is created and before
3 subsequent copies or movements are done, a check is made for this file and
4 if the file exists, then copy is prohibited.

5 JUDGE COURTENAY: So you could just copy it once is what you
6 are saying --

7 MR. SMITH: Exactly.

8 JUDGE COURTENAY: -- by referencing this history of past copies.

9 MR. SMITH: Yes. If the history is there, then you are not allowed to
10 copy anymore. So the very first time, no copy or move history is there so
11 you are allowed to copy.

12 There are two rejections made in this case. There was a 102(e)
13 rejection based on the Ichimura reference, U.S. Patent Number 6,034,832,
14 and then there was a 103 rejection based on Stock and I believe it was
15 Tanaka was the name of the other reference.

16 With the 103 rejection, I think that was the first rejection made by the
17 Examiner, the Stock reference basically deals with protecting information on
18 a RAM device or a flash device and it protects it using biometric
19 information, biometric information being a fingerprint or retinal scan or
20 something like that, and before you can access the information on the RAM
21 device, you must verify the correct biometric information.

22 But I think that reference doesn't show or teach the move file history.
23 I think the Examiner -- I wasn't really sure how he was interpreting the
24 reference but if you look at the reference, the only thing that prohibits access
25 to the data on that flash drive is a verification of the biometric. There is no

1 check of a move file history.

2 That -- I don't know if you have a different interpretation of it. I could
3 go further. Okay.

4 And the Ichimura reference, that reference the Examiner applied a
5 102(e) rejection on that.

6 The Ichimura reference, what that one is doing is it is using -- I
7 believe they call it a copy management data, so you have copy management
8 data that's stored on one DVD and that copy management data restricts
9 based on frequency, also copy history or whatever, how that DVD could be
10 copied to a separate DVD. So the Examiner is relying on that copy
11 management data to equate to our claim, copy move file history.

12 But I think if you look at the claim language, for example, claim 1,
13 we set forth that there is a large capacity memory means, so that -- and based
14 on our specification, is, for example, the hard drive that I discussed, the first
15 hard drive.

16 The Examiner equates the large capacity memory means to the DVD
17 device of the Ichimura reference. And then we also claim a memory means
18 for storing the move copy history. Again, the Examiner seems to equate
19 back to the DVD for the memory means.

20 What we have is a separate memory means. We never store the copy
21 history to the hard drive. By storing it to the hard drive, it kind of defeats
22 the purpose because if you could copy the data on the hard drive, then you
23 could also copy the move file history.

24 What the specification discloses is this is stored on a separate device.
25 Here claimed as a memory means is an external storage device for the hard

1 drive that's stores the copy file history. So you have to actually check that
2 external storage device for the copy move file history. You are not checking
3 back to the -- well, in this case, I guess the Ichimura reference would be the
4 DVD.

5 So I think that's one of the main distinctions between what we are
6 claiming, which is three separate storage means, you have the large capacity
7 memory means, you have the memory means which stores the copy move
8 file history and then there is a separate nonvolatile memory which would be
9 the portable flash device that we store the data to.

10 JUDGE COURTENAY: So are you acknowledging that the Ichimura
11 reference teaches this copy history?

12 MR. SMITH: I acknowledge that it teaches some form of copy
13 history stored on the DVD device.

14 JUDGE COURTENAY: So what you are arguing is that we don't
15 have the arrangement of memory means and reference means and so forth --

16 MR. SMITH: Correct.

17 JUDGE COURTENAY: -- as you just described.

18 MR. SMITH: Correct, your Honor.

19 JUDGE SIU: So do you feel that the DVD and the large capacity
20 memory means are distinct?

21 MR. SMITH: I think that would be a tough argument to make based
22 on the claim, how it is written here, determining a large capacity memory
23 means broadly interpreted, I think leeway could be given to the rejection to
24 the Examiner saying a DVD is a large capacity memory means.

25 I mean in our disclosure what we were referring to was a hard drive,

1 for example, of an apparatus in a computer but, again, the claim, as it stands
2 now, large capacity memory means, I don't really think I would be
3 comfortable to say, you know, the Examiner is completely incorrect in
4 interpreting a DVD to be a large capacity memory means.

5 I mean that's, basically, I think, the main distinction is the fact that we
6 are storing our copy history separate –

7 JUDGE COURTENAY: It is external.

8 MR. SMITH: It is external. It is not stored.

9 JUDGE COURTENAY: That's the distinction you are arguing over
10 the prior art.

11 MR. SMITH: Yes, that's the main distinction here and I think the
12 reason why is explicit in the specification. We do that because if you store
13 it, it kind of defeats the purpose to have it on the memory device itself if you
14 are trying to prevent unauthorized copying.

15 Someone could easily copy it from that because they have access to
16 the data on the file, they would also have access to the data on the memory
17 device.

18 JUDGE SIU: So if the copy data in the prior art Ichimura is stored in
19 a place other than the DVD that's labeled "1" in figure 1, would that be
20 equivalent to the memory means that is stored in some other memory other
21 than this component "1"?

22 MR. SMITH: I think there would still be a distinction there because I
23 guess a general argument you could also make that if you are reading
24 something, it might be some storage somewhere, I know you might have a
25 capacitor somewhere where are storing a charge, and I think that really

1 doesn't get to the heart of the invention.

2 I mean what we are claiming here would be different. So if you were
3 going to say, well, by reading something, you store it, for example, in the
4 capacitor someplace while you are reading it, I think -- I think there is still a
5 distinction here because we never store it on the -- on this.

6 JUDGE SIU: Actually, I was thinking more along the lines of
7 element 15 in figure 1, CMD memory. If the copy management data is
8 stored there, would that be distinct or would that be equivalent to the
9 memory means as recited in claim 1?

10 MR. SMITH: What figure are you referring to?

11 JUDGE SIU: Figure 1 in Ichimura -- on the left-hand side there is a
12 component labeled "1" and then on the bottom another component labeled
13 "15", it says CMD memory?

14 MR. SMITH: Yes. So, yes, I think the specification discloses that
15 this stores solid information and this memory means disclosed or referenced
16 here in figure 1, both 15 of the reproducing apparatus and reference 27 of the
17 recording apparatus, those are external to the DVD, they are on the
18 apparatus itself, but they are not external to the device and the disclosure, if
19 you look to figure -- I believe -- 34, I believe.

20 JUDGE COURTENAY: Copy management data is stored in memory
21 15, isn't it?

22 MR. SMITH: I'm sorry?

23 JUDGE COURTENAY: The copy management data is stored in
24 memory 15 in the reference. I'm looking at column 4 of the Ichimura
25 reference, looking at line -- lines 46 and 47.

1 MR. SMITH: Yes. I see that.

2 JUDGE COURTENAY: It discloses, "The controller, 11" -- I'm
3 quoting here -- "The controller, 11, can store into the CMD memory, 15,
4 copy management data, CMD, read out from the disk, 1, to perform the
5 processing using the copy management data, CMD."

6 MR. SMITH: Yes, I see where you are referring to. But does the --
7 does the device there reference that for the history information or is it
8 referencing -- my understanding it is referencing the DVD for that. The
9 claim calls for referencing -- these are referencing history information stored
10 in the memory means.

11 My understanding is that this device disclosed in Ichimura is actually
12 referencing the CMD stored on the DVD and to do the prohibited -- the
13 prohibition of the copying. So even though it might be stored there, as it
14 says, my understanding, it doesn't reference that to conduct the transaction.

15 JUDGE SIU: And were you saying that the memory means in claim 1
16 had to be external to something? And what is that based on? Is that based
17 on figure 4 -- figure 34 or something in the claim?

18 MR. SMITH: It is based on figure 35 of the application. Figure 35
19 shows -- reference 203. It isn't in figure 34. I apologize. Figure 34 shows
20 the external in view ram.

21 JUDGE SIU: Reference 203?

22 MR. SMITH: Yes, reference 203, figure 34.

23 JUDGE SIU: And it says external -- 203 external to what? What does
24 that refer to?

25 MR. SMITH: This is external to the computer device or the hard

1 drive itself, the apparatus storing the hard drive. I want to use the claim
2 language here. The large capacity memory means.

3 JUDGE SIU: So isn't element 15 in figure 1 of Ichimura external to
4 element 1? In Ichimura, I'm talking about figure 1.

5 MR. SMITH: Yes. I believe it would be external to that, the DVD,
6 but it wouldn't be external to the apparatus and I think what the specification
7 is disclosing is this thing – this memory device is external to the apparatus
8 itself. I don't think it is shown in figure 35. I believe it is referenced in the
9 specification.

10 Let's find that for you. If you look to page 98, lines 23 down, it is
11 referring to the whole side CPU and I believe that whole side CPU is the
12 apparatus itself or at least contains an apparatus on the hard drive and this
13 reference, nonvolatile memory reference 203, is external to that. Better
14 diagram but –

15 JUDGE SIU: That says it is external to the CPU; right?

16 MR. SMITH: Yeah. I believe you are correct. I thought there was a
17 clearer distinction that showed that it was external to the overall device and
18 not just separate from the CPU or separate from the hard drive itself.

19 JUDGE BLANKENSHIP: Are we considering claim 16 separately in
20 this case?

21 JUDGE SIU: Yes. That's another issue.

22 MR. SMITH: Yes. Claim 16 is broader, I believe, than the -- than
23 claim 1, and claim 16 doesn't -- I still think that it references the separate
24 nonvolatile memory.

25 And, again, I guess we will bring it back to the argument that you are,

1 I guess, stating, that there is a separate memory in the Ichimura reference but
2 I would say that I'm not really sure that Ichimura is saying that it is
3 referencing that command or that memory to determine whether to prohibit
4 or allow the copying. I believe it is referencing the DVD itself.

5 JUDGE COURTENAY: So the copy history is stored both in the
6 memory, 15, and also on the disk, but you are saying that the disk is
7 referenced to determine whether you can reproduce the data.

8 MR. SMITH: Based on my understanding, it appears that that's what
9 the Ichimura reference is teaching. I don't know why -- this copy maybe is
10 to update the command history. Maybe that's what Dr. Ichimura is referring
11 to, but to me it doesn't appear that it is teaching that you're actually using
12 that during the process.

13 In figure 6 of the Ichimura reference, it says -- step 102, it says, "Read
14 out copy management desk. Read out copy management data from disk and
15 then check reproduction condition."

16 So, to me, it sounds like it is basing this condition or this check based
17 on the reading from the disk and not what is read and then stored maybe
18 someplace else.

19 JUDGE COURTENAY: Okay. And they describe figure 6 in, looks
20 like, the bottom of column 13 and the top of column 14 of the Ichimura
21 reference.

22 We have a disclosure in column 13 -- I'm looking at line 63 -- that we
23 read out the copy management data, the CMD data, from the disk, 1, and we
24 store the readout copy management data, CMD, into the CMD memory, 15.

25 MR. SMITH: Yes, and then at the top of column 14, it says, "The

1 CMD recorded on this disk," on disk 1, "is taken in step 103, for example,
2 the reproduction of additional copy history is shown in figure 5."

3 They are describing the copy management data, CMD, are checked.
4 So I'm not sure if it is clear whether it is -- again, it is a checking the data
5 from the disk or is it checking this memory device.

6 JUDGE BLANKENSHIP: Any other questions?

7 JUDGE COURTENAY: No further questions.

8 JUDGE BLANKENSHIP: All right. Thank you, Mr. Smith.

9 MR. SMITH: All right. Thank you so much for your time.

10 JUDGE BLANKENSHIP: We are off the record.

11
12 (Whereupon, the proceeding was concluded on Thursday, June 11,
13 2009.)